

## **REMARKS/DISCUSSION:**

This Amendment C is being filed within three months after the shortened statutory period for response that ended on July 17, 2006. Accordingly, a Petition for a Three-Month Extension of Time is attached hereto.

By this Amendment C, claims 20-27 are pending in this application. Claim 20 has been amended. Support for the amendment can be found at Figs. 1a-b, 2b and 4a-b.

Amendment and/or cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims previously presented. Further, Applicant(s) reserves the right to prosecute the subject matter of such claims in continuation and/or divisional applications.

Applicants have carefully studied the outstanding Office Action. This Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

### **Rejection under 35 U.S.C. § 102(b)**

Claims 20-23 stand rejected as being anticipated by each of U.S. Patent Nos. 3,971,270 to Wallace; 4,827,930 to Kees; 3,399,456 to Johnson; and 6,776,616 to Dryer.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim, and the elements must be arranged as required by the claim. Under this standard, Applicants submit that neither of the above references fail to anticipate amended independent claim 1.

The Examiner states that Wallace discloses an instrument having two jaws and two lever arms 10 and 12 where the jaws and arms overlap. Applicants respectfully disagree with the Examiner. Specifically, and with respect to independent claim 20, Wallace does not disclose “distal ends of the first and second lever arms interface in an overlapping relationship”. (Emphasis added.) Further, Wallace does not disclose “lever arms in combination form a substantially U-shaped structure”. (Emphasis added.) Further, Wallace does not disclose “lever arms in combination form a substantially U-shaped structure for slidably receiving a finger from the proximal end towards the distal end” [of the lever arms]. (Emphasis added.)

The Examiner states that Kees discloses an instrument having two jaws 54, 58 and two arms 24, 26. Applicants respectfully disagree with the Examiner. Specifically, and with respect to independent claim 20, Kees does not disclose “distal ends of the first and second lever arms interface in an overlapping relationship”. (Emphasis added.) Further, Kees does not disclose “lever arms in combination form a substantially U-shaped structure”. (Emphasis added.) Further, Kees does not disclose “lever arms in combination form a substantially U-shaped structure for slidably receiving a finger from the proximal end towards the distal end” [of the lever arms]. (Emphasis added.)

The Examiner states that Johnson discloses an instrument having two jaws and two arms, both of which overlap as shown in fig. 1 and 6. Applicants respectfully disagree with the Examiner. Specifically, and with respect to independent claim 20, Johnson does not disclose “distal ends of the first and second lever arms interface in an overlapping relationship”. (Emphasis added.) Further, Johnson does not disclose “lever arms in combination form a substantially U-shaped structure”. (Emphasis added.) Further, Johnson does not disclose “lever arms in combination form a substantially U-shaped structure for slidably receiving a finger from the proximal end towards the distal end” [of the lever arms]. (Emphasis added.)

The Examiner states that Dryer discloses an instrument in fig. 6 having two jaws 612, 614 and two arms 602, 604. Applicants respectfully disagree with

the Examiner. Specifically, and with respect to independent claim 20, Dryer does not disclose “distal ends of the first and second lever arms interface in an overlapping relationship”. (Emphasis added.) Further, Dryer does not disclose “lever arms in combination form a substantially U-shaped structure”. (Emphasis added.) Further, Dryer does not disclose “lever arms in combination form a substantially U-shaped structure for slidably receiving a finger from the proximal end towards the distal end” [of the lever arms]. (Emphasis added.)

Claims 21-23 all depend from claim 20. Applicants submit that these claims are likewise patentable over the cited references for at least the same reasons as discussed above with respect to claim, by virtue of their dependency from claim 1. Withdrawal of the rejections as to these claims is likewise requested.

#### Rejection under 35 U.S.C. § 103

Claims 20-27 stand rejected as being unpatentable over Myers et al. (USP 5,925,064) in view of Johnson et al. ('456) and Bonta (USP 987,095).

Under MPEP 2143, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In view of the foregoing requirements for a *prima facie* case of obviousness, Applicants submit that the combined art of record fails to render the claims obvious. In particular, Applicants note that the combination of references fails to teach or suggest all of the limitations of independent claim 20 in accordance with MPEP 2143.03. In addition, Applicants submit that even if the combined art of record taught or suggested all of the limitations of each

present independent claim, there is no teaching, suggestion, or motivation to modify or combine the references to obtain the invention presently claimed, such that a *prima facie* case of obviousness has not been, and cannot be, established in accordance with MPEP 2143.01.

For instance, Applicants submit that the combined art of record fails to teach or suggest all of the limitations recited in independent claim 20. In particular, the combined art of record fails to teach or suggest, among other things, “distal ends of the first and second lever arms interface in an overlapping relationship”; “lever arms in combination form a substantially U-shaped structure”; and “lever arms in combination form a substantially U-shaped structure for slidably receiving a finger from the proximal end towards the distal end”. Neither Myers et al. nor any of the other references teach such limitations. Accordingly, the combined art of record fails to render independent claim 20 obvious in accordance with MPEP 2143.03. Applicants therefore respectfully request that the rejections be withdrawn.

Furthermore, even if the combined art of record taught or suggested all of the elements of any of the independent claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). *Actual evidence* of a suggestion, teaching, or motivation to combine prior art references must be shown. *In re Dembiczack*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is also well settled that an “obvious to try” rationale is insufficient to satisfy the Office’s burden under MPEP 2143.01.

In formulating the pending §103 rejections, the Office has failed to articulate any motivation whatsoever to combine or modify the teachings of the references in order to obtain the invention presently claimed. Instead, the Office has merely cobbled together random teachings of the prior art in order to allegedly find the subject matter of limitations recited in the present claims.

Upon completion of such cobbling, the Office simply concludes “Therefore, it would have been obvious,” without any further explanation. At most, this amounts to nothing more than an “obvious to try” rationale, which is clearly unacceptable under MPEP 2145. Again, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In addition to failing to articulate any rationale to establish the motivation required by MPEP 2143.01, the Office has failed to provide any evidence to support such a rationale. In short, without any rationale on motivation to combine/modify, and without any actual evidence to support the same, the Office has fallen far short of its burden under MPEP 2143.01. Because the motivation element of a *prima facie* obviousness case required by MPEP 2143.01 is lacking, Applicants respectfully request that the rejections be withdrawn.

Further, beyond the foregoing shortcomings with respect to the rejections of independent claim 20, Applicants further note that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and nonobviousness.

Applicants further object to the Office’s use of “omnibus rejections,” which impermissibly group claims together and fail to address each and every limitation recited in those claims. By way of example only, the Office has not addressed the limitations added by claims 21-27, such that the Applicants have not been given a full and fair opportunity to address the rejections of the same. Omnibus rejections such as those used in the present Office Action are improper under MPEP 707.07(d), and the Office is respectfully requested to treat each and every limitation of each and every claim on its own merits in the next Office Action.

### **Conclusion**

Applicants submit that in view of the discussion, the rejections under 35 U.S.C. §§ 102(b) and 103 have been overcome and that the invention is now

patentable over the cited prior. The Examiner is respectfully requested to reconsider all rejections and pass this case to issue.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, which may be required to Account No. 10-0750/END-5017/VEK.

Respectfully submitted,

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